

AFTER FINAL**REMARKS**

This amendment is responsive to the Final Office Action dated December 12, 2003. Following the instant Amendment, Claims 1-20 are pending in the present application. Claims 1, 11 and 19 are hereby amended to further define the invention. Applicants have specifically addressed each and every one of the Office Actions rejections in the amendments and remarks herein. Claim 17 was not substantively addressed in the Office Action and Applicants reserve the right to substantively address the same in future correspondence. Thus, Applicants respectfully submit that the remaining claims, as amended herewith, are allowable and an early notification of allowance is requested.

This response is being filed within six (6) months from the mailing date of the Office Action and a Petition for an Extension of Time is filed herewith along with the appropriate fee in the accompanying credit card payment form.

I. Drawings

The drawings were objected to under 37 CFR 1.83(a) for not showing every feature of the invention specified in the claims. Applicants hereby submit a new drawing sheet which includes Figure 5 that shows the telescopic nature of the invention and the electricity wire extending therefrom.

With respect to the retractable protruding member, Applicants respectfully assert that reference numeral 24 of Figures 1 and 2 clearly shows the retractable protruding member and reference numeral 26 of Figure 2 also illustrates the resilient member. However, if the Office

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requires additional drawings illustrating the same, Applicants are ready to provide the same upon guidance from the Office as the new drawings that are required in addition to the drawings which are currently present in the file.

II. Claim Rejections – 35 USC §103

Applicants note that the rejection of the claims under the previously cited references in the prior Office Action was withdrawn as a result of the Applicants' July 11, 2003, response thereto. Accordingly, the Office shared Applicants' belief that the previously cited prior art failed to teach or render obvious Applicants' claimed invention.

The Office Action rejected Claims 1, 2, 5, 7, 11 & 18 under 35 USC 103 as being unpatentable over newly cited Hillinger (US Pat No. 5,692,828) and presumed official notice. Applicants respectfully traverse the rejection and the modification and interpretation of the references, and assert that the subject claims are unobvious and are allowable.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. Hillinger fails to suggest any reason to modify the reference as proposed by the Office Action. In fact the reference is individually complete and functional independently for the limited specific purpose of employment as a hazard warning light. As can be discerned, Hillinger fails to teach Applicants' interchangeable display elements that provide, in addition to illumination, a display element that can project messages or seasonal presentations and can be directly inserted into the ground. Accordingly, from reviewing the cited reference, it is clear that the reference provides no

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motivation for the combination or modification as proposed by the Office.

In addition, the Office Action also appreciates the advantages of Applicants' invention and is using hindsight and Applicants' invention in order to modify the reference in attempt to render Applicants' claims obvious. Applicants respectfully assert that if the invention were in fact obvious, because of the advantages it provides in easily transitioning between different display elements, those skilled in the art surely would have implemented it by now. That is, the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

Furthermore, the Office Action seems to recognize the advantages of the present invention by trying to make modifications in three references to achieve the claimed invention. Applicants respectfully submit that the fact the modification produces advantages in efficiently transitioning between different display elements militates in favor of Applicants because it proves that Applicants' invention produces new and unexpected results and hence is unobvious. Moreover, Applicants' limitations, as set forth in the claims, are not rendered obvious and remarks are presented hereinafter with respect to each claim and the failure of the references to render the same obvious.

Regarding **Claims 1 and 11**, even if the modification were legally justified, it still would not render Applicants' invention obvious. Applicants' invention claims an interchangeable display element that may be adapted to exhibit illuminated messages or seasonal ornamentation. In addition, Applicants' invention is directly attachable to the ground. Hillinger fails to either teach or even contemplate the same. Hillinger teaches alternate preferred embodiments for its hazard display element and does not provide for easily transitioning between varying design elements as taught by Applicant, "The second embodiment of the assembly 10 differs from the preferred embodiment in the method of attaching the lens head 18 to the elongated body 12..." (Hillinger, col. 7, lines 5-7). Therefor, Applicant respectfully requests withdrawal of the

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rejection of Claim 1 for at least the aforementioned reasons.

Regarding Claim 2, it depends from Claim 1 and incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Hillinger teaches the use of a lens to concentrate a light beam for purposes of a hazard warning and not for aesthetic purposes. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 2 for at least the aforementioned reasons.

Regarding Claim 5, which depends from Claim 1, and other intervening claims, incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 5 for at least the aforementioned reasons.

Regarding Claim 7, which depends from Claim 1, and other intervening claims, incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. In addition, Claim 7 claims the limitation of a tubular support element receiving an extending element, which extending element receives the affixing element therein, such that the height of the device can be varied. Hillinger fails to disclose or teach that the height of its warning hazard light can be varied and the absence of a citation to the specification or reference numerals by the Office Actions only buttresses such failure on the part of Hillinger. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 7 for at least the aforementioned reasons.

Regarding Claim 18, it depends from Claim 11 and incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Therefor, Applicants respectfully request withdrawal of the rejection of Claim 18 for at least the aforementioned reasons.

The Office Action rejected Claims 3, 4, and 12 under 35 USC 103 as being unpatentable over Hillinger in view of Moriel (US Pat. No. 5,319,365). Applicants respectfully traverse the

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rejection and the combination, modification and interpretation of the references, and assert that the subject claims are unobvious and are allowable.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references cited by the Office suggest any reason to modify the references as proposed. In fact the references are individually complete and functional independently for each limited specific purpose and fail to suggest any motivation to modify or combine the same. Hillinger teaches a warning hazard light device that is attached to a base that requires extending legs to stabilize the same. Moriel teaches an attachment to a glass body that teaches away from Hillinger's device because the glass body cannot be used outside as a result of its fragile nature. As can be discerned, Hillinger and Moriel fail to teach Applicants' interchangeable display elements that provide, in addition to illumination, a display element that can project messages or seasonal presentations and that can be inserted into the ground. Accordingly, from reviewing the cited references, it is clear that the references provide no motivation for the combination or modification of unrelated and disparate inventions as proposed by the Office.

In addition, the Office Action also appreciates the advantages of Applicants' invention, and is using hindsight and Applicants' invention in order to modify and combine the references in attempt to render Applicants' claims obvious. Applicants respectfully assert that if the invention were in fact obvious, because of the advantages it provides in easily transitioning between different display elements and providing different lighting levels for outdoor lights affixed to the ground, those skilled in the art surely would have implemented it by now. That is, the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

Furthermore, the Office Action seems to recognize the advantages of the present

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invention by trying to make modifications in five disparate references to achieve the claimed invention. Applicants respectfully submit that the fact the modification produces advantages in efficiently transitioning between different display elements and providing lighting at differing heights militates in favor of Applicants because it proves that Applicants' invention produces new and unexpected results and hence is unobvious. Moreover, Applicants' limitations, as set forth in the claims, are not rendered obvious and remarks are presented hereinafter with respect to each claim and the failure of the references to render the same obvious.

Regarding **Claim 3**, which depends from Claim 1, and other intervening claims, incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Applicants' protruding elements allow for easy transition between various design elements whereas Moriel's device teaches a more permanent attachment. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 3 for at least the aforementioned reasons.

Regarding **Claim 4**, which depends from Claim 1, and other intervening claims, incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. In addition, Claim 4 claims the limitation of a retractable protruding member which accommodates the interchangeable aspects of Applicants' display element. Neither Hillinger nor Moriel teach or even contemplate Applicants' retractable protruding member for attachment of their respective devices. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 4 for at least the aforementioned reasons.

Regarding **Claim 12**, it depends from Claim 11 and incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. In addition, Claim 11 claims the limitation of a retractable protruding member which accommodates the interchangeable aspects of Applicants' display element. Neither Hillinger nor Moriel teach or even contemplate Applicants' retractable protruding member for attachment of their respective devices. Therefor, Applicant respectfully

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requests withdrawal of the rejection of Claim 12 for at least the aforementioned reasons.

The Office Action rejected Claims 6, 8, 13, 14, 16 and 19 under 35 USC 103 as being unpatentable over Hillinger in view of either Bosnakovic (US Pat No. 6,454,228) or Her (USPN 5,278,735). Applicants respectfully traverse the rejection and the combination, modification and interpretation of the references, and assert that the subject claims are unobvious and are allowable.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references cited by the Office suggest any reason to modify the references as proposed. In fact the references are individually complete and functional independently for each limited specific purpose and fail to suggest any motivation to modify or combine the same. Hillinger teaches functional warning hazard light. Bosnakovic teaches a functional tripod for use in the video and photographic industries. Her teaches a functional distress signal lamp assembly. As can be discerned, Hillinger, Bosnakovic and Her fail to teach Applicants' interchangeable display elements that provide, in addition to illumination, a display element that can project messages or seasonal presentations. Accordingly, from reviewing the cited references, it is clear that the references provide no motivation for the combination or modification of unrelated and disparate inventions as proposed by the Office.

In addition, the Office Action also appreciates the advantages of Applicants' invention and is using hindsight and Applicants' invention in order to modify and combine the references in attempt to render Applicants' claims obvious. Applicants respectfully assert that if the invention were in fact obvious, because of the advantages it provides in easily transitioning between different display elements and providing different lighting levels for outdoor lights

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affixed to the ground, those skilled in the art surely would have implemented it by now. That is, the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

Furthermore, the Office Action seems to recognize the advantages of the present invention by trying to make modifications in five disparate references to achieve the claimed invention. Applicants respectfully submit that the fact the modification produces advantages in efficiently transitioning between different display elements and providing lighting at differing heights militates in favor of Applicants because it proves that Applicants' invention produces new and unexpected results and hence is unobvious. Moreover, Applicants' limitations, as set forth in the claims, are not rendered obvious and remarks are presented hereinafter with respect to each claim and the failure of the references to render the same obvious.

Regarding **Claims 6, 8, 13 and 14**, even if the modification were legally justified, it still would not render Applicants' invention obvious. Applicants hereby incorporate the remarks set forth above with respect to the failure of Hillinger to render Applicants' invention obvious. Furthermore, Her teaches a warning hazard light assembly with suction cups that are attachable to a vehicle. Bosnakovic, on the other hand, teaches a device for use in photography with complicated tripod levers. Accordingly, none of the references either teach or even contemplate Applicant's invention that allows the lighting element to be maintained at different heights and to be easily exchangeable. Therefore, Applicants respectfully request withdrawal of the rejection of Claims 6, 8, 13 and 14 for at least the aforementioned reasons.

Regarding **Claim 16**, it depends from Claim 11 and intervening claims and incorporates the novel and unobvious limitations thereof. In addition, Applicants incorporate herein by reference the remarks set forth above regarding the failure of Hillinger, Her, and Bosnakovic to render Applicants' invention obvious. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 16 for at least the aforementioned

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reasons.

Regarding **Claim 19**, it depends from Claim 11 and intervening claims and incorporates the novel and unobvious limitations thereof. In addition, Applicants incorporate herein by reference the remarks set forth above regarding the failure of Hillinger, Her, and Bosnakovic to render Applicants' invention obvious. Furthermore, Claim 19, as amended, positively recites that Applicants' invention is liquid impermeable, a limitation which is neither taught by or rendered obvious by the cited references. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 19 for at least the aforementioned reasons.

The Office Action rejected **Claims 9, 10, and 15** under 35 USC 103 as being unpatentable over Hillinger in view of Shalvi (US Pat. No. 6,120,165). Applicants respectfully traverse the rejection and the combination, modification and interpretation of the references, and assert that the subject claims are unobvious and are allowable.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references cited by the Office suggest any reason to modify the references as proposed. In fact the references are individually complete and functional independently for each limited specific purpose and fail to suggest any motivation to modify or combine the same. Hillinger teaches a warning hazard light device that is attached to a base that requires extending legs to stabilize the same. Shalvi teaches a solar lamp that has a motion detector which is activated if an intruder is present. As can be discerned, Hillinger and Shalvi fail to teach Applicants' interchangeable display elements that provide, in addition to illumination, a display element that can project messages or seasonal presentations and that can be inserted into the ground. Accordingly, from reviewing the cited references, it is clear that the references provide no motivation for the

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combination or modification of unrelated and disparate inventions as proposed by the Office.

In addition, the Office Action also appreciates the advantages of Applicants' invention and is using hindsight and Applicants' invention in order to modify and combine the references in attempt to render Applicants' claims obvious. Applicants respectfully assert that if the invention were in fact obvious, because of the advantages it provides in easily transitioning between different display elements and providing different lighting levels for outdoor lights affixed to the ground, those skilled in the art surely would have implemented it by now. That is, the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

Furthermore, the Office Action seems to recognize the advantages of the present invention by trying to make modifications in five disparate references to achieve the claimed invention. Applicants respectfully submit that the fact the modification produces advantages in efficiently transitioning between different display elements and providing lighting at differing heights militates in favor of Applicants because it proves that Applicants' invention produces new and unexpected results and hence is unobvious. Moreover, Applicants' limitations, as set forth in the claims, are not rendered obvious and remarks are presented hereinafter with respect to each claim and the failure of the references to render the same obvious.

Regarding **Claim 9**, it depends from Claim 1, and other intervening claims, and incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 9 for at least the aforementioned reasons.

Regarding **Claim 10**, it depends from Claim 1, and other intervening claims, and incorporates the novel and unobvious limitations thereof. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Therefor,

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Applicant respectfully requests withdrawal of the rejection of Claim 10 for at least the aforementioned reasons.

Regarding **Claim 15**, it depends from Claim 11 and intervening claims and incorporates the novel and unobvious limitations thereof. In addition, Applicants incorporate herein by reference the remarks set forth above regarding the failure of Hillinger and Shalvi to render Applicants' invention obvious. Accordingly, even if the modification were legally justified, it still would not render Applicants' invention obvious. Therefor, Applicant respectfully requests withdrawal of the rejection of Claim 15 for at least the aforementioned reasons.

The Office Action rejected **Claim 20** under 35 USC 103 as being unpatentable over Hillinger in view of Moriel, either Bonakovic or Her, and Shalvi. Applicants respectfully traverse the rejection and the combination, modification and interpretation of the references, and assert that the subject claim is unobvious and allowable.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references cited by the Office suggest any reason to modify the references as proposed. In fact the references are individually complete and functional independently for each limited specific purpose and fail to suggest any motivation to modify or combine the same. Hillinger teaches a hazard warning light of a fixed height. Moriel teaches a connection method to a glass fixture. Bonakovic teaches a tripod for use in the photographic industry. Her teaches another warning hazard light with suction cups for attachment to a vehicle. Finally, Shalvi teaches a solar lamp that has a motion detector which is activated if an intruder is present. Accordingly, from reviewing the cited references, it is clear that the references provide no motivation for the combination or modification of unrelated and disparate inventions as proposed by the Office.

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In addition, the Office Action also appreciates the advantages of Applicants' invention and is using hindsight and Applicants' invention in order to modify and combine the references in attempt to render Applicants' claims obvious. Applicants respectfully assert that if the invention were in fact obvious, because of the advantages it provides in easily transitioning between different display elements and providing different lighting levels for outdoor lights affixed to the ground, those skilled in the art surely would have implemented it by now. That is, the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

Furthermore, the Office Action seems to recognize the advantages of the present invention by trying to make modifications in five disparate references to achieve the claimed invention. Applicants respectfully submit that the fact the modification produces advantages in efficiently transitioning between different display elements and providing lighting at differing heights militates in favor of Applicants because it proves that Applicants' invention produces new and unexpected results and hence is unobvious. Moreover, Applicants' limitations, as set forth in the claims, are not rendered obvious and remarks are presented hereinafter with respect to each claim and the failure of the references to render the same obvious.

Applicants incorporate herein all of the remarks set forth above with respect to all of the claim limitations and the cited references' failure to teach or contemplate the same and their failure to render the same obvious. In addition, Applicants note the Office Action's preemptive citation of In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991) in an attempt to deflect the numerous references cited by the Office in an attempt to render Applicants' claims obvious. Applicants respectfully assert that the facts of In re Gorman are distinguishable from the instant case. In In re Gorman, the court held that the confectionary invention, candy in the shape of a human thumb, was obvious despite the numerous references cited because the references themselves provided the motivation for the combination, "When it is necessary to

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select elements of various teachings in order to form the claimed invention, we ascertain whether **there is any suggestion or motivation in the prior art to make the selection made by the applicant.**” However, the court held that “It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” In the instant case, the references fail to themselves suggest any motivation for their combination as proposed in the Office Action. In fact, the Office is improperly using Applicants’ invention as a guide map and selecting elements from references that fail to provide any motivation for their combinations in an attempt to render Applicants’ claims obvious. In such a situation, the court held that the use of the numerous references in a piecemeal manner would bolster Applicants’ assertion that its claims are in fact unobvious.

As a result, for at least the aforementioned reasons, Applicants’ respectfully request the withdrawal of the rejection of Claim 20.

III. Claim 17 Not Addressed

There was no substantive rejection of Claim 17 in the instant Office Action and Applicants assume that Claim 17 is therefore allowable. However, should Claim 17 be rejected in a further Office Action, Applicants reserve the right to argue the same to allowance.

IV. References Made of Record

Applicants have reviewed the references made of record and respectfully assert that none of the references therein either anticipates Applicants’ invention or renders the same obvious.

CONCLUSION

It is respectfully submitted that the case is now in condition for allowance, and an early

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notification of the same is requested. If it is believed that a telephone interview will help further the prosecution of this case, Applicants respectfully request that the undersigned attorney be contacted at the listed telephone number.

Respectfully submitted,

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